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EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/479,918

Applicant(s)

KLATT ET AL.

Examiner

Ella Colbert

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 & 5. 6) ☐ Other:

**DETAILED ACTION**

1. Claims 1-32 are pending.
2. The IDS filed 05/23/01 has been reviewed and entered as paper no. 4. The IDS filed 01/17/03 has been reviewed and entered as paper no. 5.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,563,999) Yaksich et al, hereafter Yaksich in view of (US 6,330,542) Sevcik et al, hereafter Sevcik.

With respect to claim 1, Yaksich teaches, (1) monitoring the sales management system to detect a predefined sales event (col. 2, lines 4-67); (2) in response to detecting the predefined sales event in step (1), generating event data comprising information that describes the sales event (col. 1, 49-67, col. 2, lines 1-67). Yaksich did not teach, (3) in a print processing facility, receiving the event data, comparing the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generating a print order for the printed product using information extracted from the event data.

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Sevcik discloses, (3) in a print processing facility, receiving the event data, comparing the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generating a print order for the printed product using information extracted from the event data (col. 1, lines 11-22, col. 3, lines 42-65, col. 6, lines 28-67, and col. 7, lines 1-2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a print processing facility for receiving the event data, comparing the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generating a print order for the printed product using information extracted from the event data and to modify in Yaksich in view of Yaksich's manufacturing (printing) facility at a number of geographically remote locations and because such a modification would allow Yaksich to manage commercial printing and the inefficiencies that exist for both the buyers of commercial printing and the providers (see Sevcik - col. 1, lines 8-16).

With respect to claim 2, Yaksich did not teach, wherein step (3) comprises the step of automatically generating a procurement request that requires approval by a corporate employee; and further comprising the step of approving the procurement request before the printed product is produced.

Sevcik discloses, wherein step (3) comprises the step of automatically generating a procurement request that requires approval by a corporate employee; and further comprising the step of approving the procurement request before the printed product is

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produced (col. 5, lines 21-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the step of automatically generating a procurement request that requires approval by a corporate employee; and further comprising the step of approving the procurement request before the printed product is produced and to modify in Yaksich because such a modification would allow Yaksich to understand the significance of receiving an immediate quote computed from various print providers, to consider the process involved, the transaction costs to the organization, and the steps that are apart of the process before the printed product is produced.

With respect to claim 3, Yaksich teaches, transmitting the procurement request to a procurement system located at a corporate facility (col. 8, lines 28-34, col. 9, line 1 to col. 11, line 39).

With respect to claim 4, Yaksich teaches, further comprising the step of transmitting the approval to the print processing facility which, in response thereto, produces the printed product (col. 39, lines 39-42).

With respect to claim 5, Yaksich teaches, wherein the print order comprises a print production request that is directly fulfilled by a print production system without further approvals (col. 40, lines 65-67 and col. 41, lines 1-17).

With respect to claim 6, Yaksich did not teach, further comprising the step of checking one or more print criteria that must be satisfied before the printed product is actually produced.

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Sevcik discloses, further comprising the step of checking one or more print criteria that must be satisfied before the printed product is actually produced (col. 6, lines 27-67 and col. 7, lines 1-2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a step for checking one or more print criteria that must be satisfied before the printed product is actually produced and to modify in Yaksich because such a modification would allow Yaksich for the customer (buyer) to have the capability to look at several print options and types of variables prior to the printed product being produced.

With respect to claim 7, Yaksich did not teach, wherein the printed product comprises sales literature.

Sevcik discloses, the printed product comprises sales literature (col. 7, lines 3-12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the printed product comprise sales literature and to modify in Yaksich because such a modification would allow Yaksich to have what is known as marketing collateral which includes sales and data sheets and brochures (sales literature).

With respect to claim 8, Yaksich and Sevcik did not teach, wherein the printed product comprises an award for a sales employee, but it would have been obvious to one having ordinary skill in the art at the time the invention was made for the printed product to comprise an award for a sales employee and to modify in Yaksich and Sevcik because such a modification would allow Yaksich and Sevcik to have a different design

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option and for the user to have the capability to print the specifications of the design (see col. 8, lines 59-64 –Sevcik).

With respect to claim 9, Yaksich did not teach, further comprising the step of transmitting over the Internet the event data to the print processing facility.

Sevcik discloses, the step of transmitting over the Internet the event data to the print processing facility (col. 3, lines 21-41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to transmit over the Internet the event data to the print processing facility and to modify in Yaksich because such a modification would allow Yaksich to have an automated Internet system that features a series of graphical interfaces which represent various printed products that are linked to a database of prices and other variable option from various print providers and to have the optimal equipment for the project to be computed and for the project to be produced on the most efficient equipment for that particular product.

With respect to claim 10, Yaksich did not teach, further comprising the step of retrieving corporate specific information in addition to the event data and using the corporate-specific information to generate a print production request. Sevcik discloses, retrieving corporate specific information in addition to the event data and using the corporate-specific information to generate a print production request (col. 3, lines 41-67 and col. 4, lines 1-4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to retrieve corporate specific information in addition to the event data and use the corporate-specific information to generate a print production request and to modify in Yaksich because such a modification would allow

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Yaksich to have a system that has a complex database of information for custom products which allows for search and retrieval of specific information and automatically generates quotes for custom products and ensures the project is produced on the equipment for that particular product

With respect to claim 11, Yaksich and Sevcik did not teach, wherein the corporate-specific information comprises a corporate logo that is not stored in the corporate database, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have corporate-specific information comprises a corporate logo that is not stored in the corporate database and to modify in Yaksich and Sevcik because such a modification would allow Yaksich and Sevcik to have the information that is entered to become part of the database for that item (the item could be a corporate logo).

With respect to claim 12, Yaksich did not teach, wherein step (3) comprises the step of generating a print production request to produce the printed product without any human intervention at the corporate facility and without any human intervention at the print production facility. Sevcik discloses, generating a print production request to produce the printed product without any human intervention at the corporate facility and without any human intervention at the print production facility (col. 9, lines 26-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to generate a print production request to produce the printed product without any human intervention at the corporate facility and without any human intervention at the print production facility and to modify in Yaksich because such a modification would



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allow Yaksich to have a system have a home page that includes all of the information that a print buyer needs in order to send a print production job over the Internet from a corporate facility to a print production facility.

With respect to claim 13, Yaksich teaches, further comprising the step of translating at least some of the event data into a common print production request based on a schema mapping between fields in the corporate database and fields stored in the print processing facility (col. 11, lines 30-39 and col. 13, line 1 to col. 16, line 55).

With respect to claim 14, Yaksich teaches, (4) monitoring a second corporate sales management system to a second predefined sales event different from the predefined sales event of step (1) (col. 5, lines 30-46); (5) in response to detecting the second predefined sales event in step (4), generating second event data comprising information that describes the second predefined sales event (col. 6, lines 58-67 and col. 7, lines 1-9); and (6) in the print processing facility, receiving the second event data, comparing the second event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generating a second print order for the printed product using information extracted from the second event data (col. 7, lines 10-64).

With respect to claim 15, Yaksich teaches, wherein the predefined sales event comprises adding a new client to a client list (fig. 16-customer ID and Job ID#) (customer list with new client added at the bottom of the list).

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With respect to claim 16, Yaksich teaches, further comprising the step of creating the one or more event rules by specifying parameters on a computer screen (col. 12, lines 20-34 and col. 14, lines 50-57).

With respect to claim 17, Yaksich teaches, a computer-implemented database monitor located at a corporate facility, wherein the database monitor detects changes to the corporate sales management system and, in response thereto, generates event data comprising information that describes the sales management event (col. 5, lines 30-61). Yaksich did not teach, a print processing facility, located at a geographic location different from the corporate location and coupled to the database monitor over a network, wherein the print processing facility receives the event data, compares the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generates a print order for the printed product using information extracted from the event data. Sevcik discloses, a print processing facility, located at a geographic location different from the corporate location and coupled to the database monitor over a network, wherein the print processing facility receives the event data, compares the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generates a print order for the printed product using information extracted from the event data (col. 1, lines 11-22, col. 3, lines 42-65, col. 6, lines 28-67, and col. 7, lines 1-2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a print processing facility, located at a geographic location

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different from the corporate location and coupled to the database monitor over a network, wherein the print processing facility receives the event data, compares the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generates a print order for the printed product using information extracted from the event data and to modify in Yaksich in view of Yaksich's manufacturing (printing) facility at a number of geographically remote locations and because such a modification would allow Yaksich to manage commercial printing and the inefficiencies that exist for both the buyers of commercial printing and the providers (see Sevcik - col. 1, lines 8-16).

This claim is also rejected for the similar rationale given above for claim 1.

With respect to claim 18, this dependent claim is rejected for the similar rationale given above for claim 2.

With respect to claim 19, this dependent claim is rejected for the similar rationale given above for claims 3 and 4.

With respect to 20, this dependent claim is rejected for the similar rationale given above for claim 4.

With respect to 21, this dependent claim is rejected for the similar rationale given above for claim 5.

With respect to claim 22, Yaksich teaches, wherein the print order comprises one or more print criteria that must be satisfied before the printed product is actually produced (col. 9 and 10, lines 25-67 and col. 11, lines 1-15).

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With respect to claim 23, Yaksich and Sevcik did not teach, wherein the print processing facility notifies a corporate employee via e-mail of the print order, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the print processing facility notify a corporate employee via e-mail of the print order and to modify in Yaksich and Sevcik because such a modification would allow Yaksich and Sevcik to have the capability to have the delivery service send the image to the client for approval and the client can contact the system by electronic mail to confirm approval of the order (notification of the print order to the client (employee) via e-mail).

With respect to claim 24, Yaksich and Sevcik did not teach, wherein the corporate employee is specified in one of the predefined event rules, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the corporate employee specified in one of the predefined event rules and to modify in Yaksich and Sevcik because such a modification would allow Yaksich and Sevcik to have a confirmation from the client (corporate employee) as to the approval to execute the order in full according to the description in the client's order (predefined event rules).

With respect to claim 25, this dependent claim is rejected for the similar rationale given above for claim 9.

With respect to claim 26, this dependent claim is rejected for the similar rationale given above for claim 10.

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With respect to claim 27, this dependent claim is rejected for the similar rationale given above for claim 11.

With respect to claim 28, this dependent claim is rejected for the similar rationale given above for claim 12.

With respect to claim 29, this dependent claim is rejected for the similar rationale given above for claim 13.

With respect to claim 30, this dependent claim is rejected for the similar rationale given above for claim 7.

With respect to claim 31, Yaksich teaches, a print processing facility coupled to a plurality of corporate locations each comprising a sales management system, wherein the print processing facility receives from each of the plurality of corporate locations event data describing a predefined sales, compares the event data to one or more predefined event rules that determine whether a printed product should be produced and, in response to a positive determination, automatically generates a print order for the printed product using information extracted from the event data (col. 1, lines 49-67, col. 2, lines 1-67, and col. 3, lines 1-29).

This independent claim is rejected for the similar rationale given above for claim 1.

With respect to claim 32, this dependent claim is rejected for the similar rationale given above for claim 15.

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***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dorfman, Alexander and Weller, Kim; (WO 98/08176) disclosed template printing.

6. In an effort to advance prosecution, the following additional reference being of particular relevance is being supplied as cited on the PTO-892 (Notice of References Cited) attached to this Office Action and listed below.

The following additional reference being of particular relevance cited on the PTO-892 (Notice of References Cited):

Sparks et al US 6,167,382 col. 3, lines 4-47.

***Inquiries***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for Official communications and 703-746-5622 for Unofficial communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



E. Colbert  
March 23, 2003